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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/772,150 | 01/29/2001 | Jun Nagai | 450100-02953 | 8684 |

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| EXAMINER | |
|---|---|
| SUKHAPHADHANA, CHRISTOPHER T | |
| **ART UNIT** | **PAPER NUMBER** |
| 2625 | |

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/772,150 | NAGAI ET AL. | |
| | Examiner | Art Unit | |
| | Christopher T. Sukhaphadhana | 2625 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *03 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-14 and 39-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14 and 39-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 January 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Amendment*

1. The Amendment in the form of a Response to Restriction Requirement filed 03 February 2004 has been entered in full.

### *Title*

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### *Specification*

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claim Objections*

4. **Claims 3 and 7** are objected to because of the following informalities: Consider replacing "signalis" on line 2 of **claim 3** with --signal is--. Consider replacing "compressing" on line 2 of **claim 7** with --compressed--. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-9, 12-14, and 39-44** are rejected under 35 U.S.C. 102(e) as being anticipated by Martin et al (U.S. Patent 6,272,484 B1, "Martin").

7. In regards to **claim 1**, Martin discloses a digital picture signal processing apparatus (Fig 3) comprising: picture processing means (ref no 405, Fig 4) for compressing a captured digital picture signal; and mode designating means (col 7, line 2) for generating a signal that designates a picture processing operation of said picture processing means to a first mode or a second mode, wherein when the first mode is designated, said picture processing means generates first compressed picture data of which the digital picture signal is compressed by a non-inversible encoding method (JPEG, col 7, line 8), and wherein when the second mode is designated, said picture processing means generates second compressed picture data of which the digital picture signal is digitized and the digitized picture signal is compressed by an inversible encoding method (GIF, col 7, line 9).

8. In regards to **claim 2**, Martin discloses a digital picture recording apparatus (Fig 3) for recording a picture as a digital signal to a record medium, comprising: picture capturing means (ref no 421, Fig 4, and col 5, line 30) for capturing a picture and generating a digital picture signal; picture processing means (ref no 405, Fig 4) for compressing the captured picture signal; mode designating means (col 7, line 2) for generating a signal that designates a picture processing operation of said picture processing means to a first mode or a second mode; recording means (ref no 409 and 415, Fig 4, and col 7, line 3) for recording an output signal of

said picture processing means to a record medium, wherein when the first mode is designated, said picture processing means generates first compressed picture data of which the digital picture signal is compressed by a non-inversible encoding method (JPEG, col 7, line 8), and wherein when the second mode is designated, said picture processing means generates second compressed picture data of which the digital picture signal is digitized and the digitized picture signal is compressed by an inversible encoding method (GIF, col 7, line 9).

9. In regards to **claim 3**, Martin further discloses in col 6, line 65, the captured digital picture signal as a digital color picture signal.

10. In regards to **claim 4**, Martin further discloses in JPEG, col 7, line 8, the non-inversible encoding process being performed by compressing a digital picture signal corresponding to an orthogonal transforming process and an entropy encoding process.

11. In regards to **claim 5**, Martin further discloses in GIF, col 7, line 9, the inversible encoding being performed by registering a pattern of any length of a data stream to a dictionary and outputting a registered number as an encoded output signal when the same pattern takes place.

12. In regards to **claim 6**, Martin further discloses in col 7, line 3, the picture processing means converting the first compressed picture data and the second compressed picture data into respective files.

13. In regards to **claim 7**, Martin further discloses in col 7, line 9, the second compressed picture data being converted into a GIF file.

14. In regards to **claim 8**, Martin further discloses in GIF, col 7, line 9, the picture processing means performing a process for digitizing a digital picture signal and a process for converting the digitized data into an index value of a GIF color table at a time.

15. In regards to **claim 9**, Martin further discloses the apparatus further comprising: reproducing means (ref no 413, Fig 4) for reproducing compressed picture data recorded on a recording medium, wherein said picture processing apparatus decompresses the reproduced compressed picture signal, generates a reproduced picture, and displaying the reproduced picture to displaying means (col 8, lines 11-13).

16. In regards to **claims 12 and 13**, all the elements set forth in these claims have been addressed in the arguments of claims 1 and 2, respectively.

17. In regards to **claim 14**, Martin discloses a data record medium (ref no 409 and 415, Fig 4) for recording a first picture file and a second picture file in such a manner that the first picture file and the second picture file are distinguishable, the first picture file being compressed in a non-inversible encoding method, the second picture file being compressed in an inversible encoding method.

18. In regards to **claims 39-44**, all the additional elements set forth in these claims have been addressed in the arguments of claims 3-8, respectively.

### *Claim Rejections - 35 USC § 103*

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

20. **Claims 10 and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al (U.S. Patent 6,272,484 B1, "Martin") as applied to claim 9, in combination with Bouton et al (*Inside Adobe Photoshop for Windows*, 1994, "Bouton").

21. In regards to **claim 10**, Martin does not expressly disclose the apparatus further comprising: enlarging means for enlarging the reproduced picture displayed on said displaying means.

22. Bouton discloses in the paragraph bridging pages 58-59, an enlarging means for enlarging the reproduced picture displayed on a displaying means.

23. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Bouton's enlarging means into Martin's apparatus.

24. The suggestion/motivation for doing so would have been to produce an image with good image size and resolution for printing to a medium-quality publication (Bouton, page 59, line 4).

25. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Bouton's enlarging means into Martin's apparatus to obtain the invention as specified in claim 10.

26. In regards to **claim 11**, Bouton further discloses on the last line of page 267, a recording means recording the enlarged picture to the record medium.

***Conclusion***

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. **Dawson (U.S. Patent 5,553,160)**, especially Fig 1B, reading on at least claim 1.

**Clouthier et al (U.S. Patent 6,583,887 B1)**, especially Fig 3, reading on at least claim 1. **Cossey (U.S. Patent 6,289,118 B1)**, especially col 3, lines 20-25, reading on at least claim 1. **Harple, Jr. et al (U.S. Patent 5,724,508)**, especially col 5, lines 34-50, reading on at least claim 1. **Hoekstra et al (U.S. Patent 6,304,277 B1)**, especially the paragraph bridging col 4-5, reading on at least claim 1. **Murata (U.S. Publication 2003/0030831 A1)** especially paragraphs 0155 and 0158, reading on at least claim 1.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher T. Sukhaphadhana whose telephone number is 703-306-4148. The examiner can normally be reached on 9a-4p M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh M. Mehta can be reached on (703) 308-5246. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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